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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,674	08/13/2007	Markus Dollinger	2400.0700000/VLC/CMB	1839
26111 7590 08/04/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER SULLIVAN, DANIELLE D				
ART UNIT		PAPER NUMBER		
1616				
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08/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,674

Applicant(s)

DOLLINGER ET AL.

Examiner

DANIELLE SULLIVAN

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-5 are pending examination on the merits.

Withdrawn rejections

Applicant's amendments and arguments filed 4/28/2009 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below are herein withdrawn.

Claim Rejections - 35 USC § 103

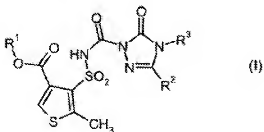
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feucht et al. (US 2005/0003963) in view of Ziemer et al. (US 2003/0078167).

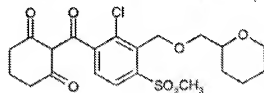
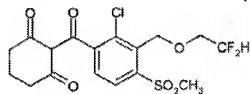
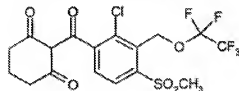
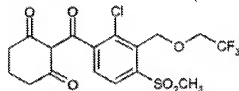
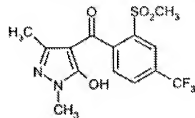
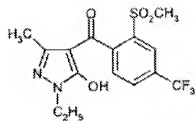
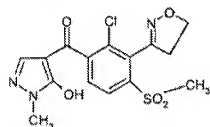
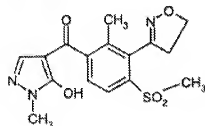
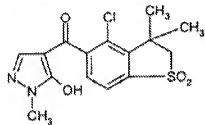
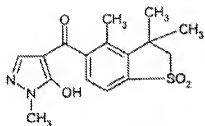
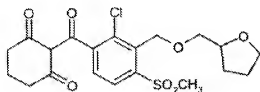
Applicant's Invention

Applicant claims a composition comprising (a) formula (I):



; (b) one or more compounds selected

from the following:



: and optionally, (c) a crop plant tolerance promoter compound, preferably benoxacor, mefenpyr-diethyl, fenchlorazole-ethyl, isoxadifen-ethyl, cloquintocet-mexyl, and N-cyclopropyl-4-[[[(2-methoxybenzoyl)amino]sulfonyl]-benzamide.

Applicants also claim a method of controlling unwanted plants by using the composition and a process of producing the composition by mixing the composition with surfactants and/or extenders.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

Feucht et al. teach herbicidal compositions comprising (a) formula (I); (b) at least one known herbicide and (c) a safener (abstract, Table 1, Example I-2). The herbicide may be a benzoylcyclohexanedione, such as sulcotrione [0016 and Table 2]. The safener may be benoxacor, mefenpyr-diethyl or isoxadifen-ethyl [0018]. The compositions can be used to treat weeds of various varieties [0043]. The formulations are produced by mixing the compounds with extenders and/or surfactants [0064].

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Feucht et al. do not teach the specific compounds (b). However, sulcotrione, a benzoylcyclohexanedione, is taught to be used as compound (b). It is for this reason that Ziemer et al. is joined.

Ziemer et al. teach that benzoylcyclohexanediones, including the specific compounds (b), are used as herbicidal crop protectants (abstract, Table I: Formula H2, H4, H7 and H8).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Feucht et al. and Ziemer et al. to utilize the specific compounds (b). One would have been motivated to include these compounds because Ziemer et al. teach that the compounds are benzoylcyclohexanediones with herbicidal activity. It would be prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in prior art." In re Kerkhoven 205 USPQ 1069, (C.C.P.A. 1980). Thus, combining the specific compounds (b) with the formula (I) as taught by Feucht et al. is obvious.

Response to Arguments

Applicant's arguments filed 4/28/2009 have been fully considered but they are not persuasive.

Applicant argues that because sulcotrione lacks substitution at the R2 position, the compounds taught by Ziemer are structurally different from sulcotrione.

The Examiner acknowledges that the compounds are structurally different. However, the core structure of the compounds is the same, meaning that the compounds of Ziemer and sulcotrione are benzoylcyclohexanediones and are taught to have herbicidal properties. As a result, a substitution of the sulcotrione with the compounds taught by Ziemer (see compound H2 on page 14, Table 1 of the Ziemer

reference) would have been suggested to one of ordinary skill as both compounds are taught to have herbicidal activity.

Applicants next argue that one of ordinary skill would not have been motivated to select the specific benzoylcyclohexanediones as a preferred compound to combine with formula (I).

The Examiner disagrees with this argument. In view of In re Kerkhoven, 205 USPQ 1069, (C.C.P.A. 1980) it would have been obvious to combine the compounds taught by Ziemer with formula (I) because they are both known to be herbicides. Furthermore, Feucht teach that the benzoylcyclohexanedione, sulcotrione, is preferably combined with formula (I). In view of KSR International Co. v. Teleflex Inc., 82 USPQ 1385 (2007), simple substitution of one known equivalent element for another to obtain predictable results is prima facie obvious. Feucht teaches that combining formula (I) with sulcotrione results in a synergistic effect [0003 and 0016]. Hence, one of ordinary skill in the art would have had a reasonable expectation of success that the simple substitution of one benzoylcyclohexanedione with another benzoylcyclohexanedione would yield predictable results.

Response to Amendment

The declaration under 37 CFR 1.132 filed 4/28/2009 is insufficient to overcome the rejection of claims 1-5 based upon Feucht et al. in view of Ziemer et al. as set forth in the last Office action because: Applicant's unexpected results are not commensurate in scope with the claims. Applicant has demonstrated synergy for treating alopecurus

myorsuroides with the combination of I-2 and B.3 in a 1:5 ratio. However, claim 1 recites a composition comprising a) at least one compound of formula (I) and b) a compound selected from different classes of compounds including benzoylcyclohexanediones comprising furan and pyran and benzoylpyrazoles. Hence, Applicant has only demonstrated synergy for the combination of 1-2 and B.3 in a 1:5 ratio, not all compounds of formula (I) and b).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 1616